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REMARKS

Examiner Leung has rejected the originally filed claims 1-5, 8, 9, 15-40 and 43-45 of the present application. For the reasons which follow, applicants respectfully traverse this rejection of the Examiner. The applicants do, however, wish to extend appreciation to Examiner Leung for the quite detailed review of the claims of the present invention leading to the finding of patentable subject matter of the originally filed claims of the present application and an indication of the allowability of claims 6, 7, 10-14, 41 and 42 if rewritten.

A Terminal Disclaimer has been filed with the United States Patent and Trademark Office. Thus, the double patenting rejection of the present application has been overcome.

The Examiner apparently concedes that the assignee's prior patent documents do not suggest the peel elements recited in claims 15 and 17-20 but contends "the exact structure...would be a matter of engineering variations...as a mere engineering expedience". It is respectfully submitted that this is not a proper ground of rejection. Specifically, as stated by the Patent Office Board of Appeals in *Ex parte Dere*, 118 U.S.P.Q. 541 (1957) at page 544:

It will be observed that the last sentence of the above quotation is a concession that the art contains no suggestion of having marked zones of perforation on opposing edges spaced according to the metric or English systems respectively. The examiner, as to this relationship, which is the very thing that yields the useful results already pointed out merely states it:

'is not seen to provide a patentable distinction, being no more than a matter of choice.'

Why he so holds he does not say and we do not see particularly since only the disclosure of the instant case makes a 'choice' available.

In view of the fact that claimed relationship has the useful advantages already enumerated, we cannot agree with this undocumented statement.

Also, as stated in the report by the Subcommittee on Quality of Examination on page 323 of the January, February and March 1990 edition of the AJPLA Bulletin:

Are the Examiners even attempting to search for what they regard as "mere matters of design choice." Federal Circuit decisions such as *In re Newell*, No. 89-1332 (Fed. Cir. Dec. 12, 1989) and *In re Kaplan*, 229 U.S.P.Q. 678, 683 (Fed. Cir. 1986), show that the Federal Circuit has recognized the problem and will insist on

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the citation of relevant art. A rejection based on "mere design choice" should be supported by the prior art.

Particularly, as set forth in *In re Kaplan*, 229 U.S.P.Q. 678, 683 (Fed. Cir. 1986):

In the later case [a mere variation of that invention which would have been obvious to those of ordinary skill in the relevant art], there must be some clear evidence to establish why the variation would have been obvious which can properly qualify as "prior art." Even if obviousness of the variation is predicated on the level of skill in the art, prior art evidence is needed to show what that level of skill was. (Bracketed material and emphasis added.)

Does the Examiner contend that the assignee's prior patent documents accomplish the same "function" in the same way? It is respectfully submitted that the prior art does not in any way suggest providing a reduced strength area in the first wall to allow the first wall to fail and peel as recited in claim 15 and/or laminates in the first wall which are not adhered together in a pattern as recited in claim 16. Thus, the rejection based upon "a matter of engineering variation" is improper as not in any way supported by the prior art.

For the sake of completeness and assuming the peel element of the present invention has "the same function" as the peelable closures of assignee's prior patent documents, which is contested by the applicants, this is not a proper basis for rejection. Specifically, as set forth in MPEP§2144.06:

In re Scott, 323 F.2d 1016, 139 USPQ 297 (CCPA 1963) ...The court reversed, holding that components which are functionally or mechanically equivalent are not necessarily obvious in view of one another,...

Examining the Scott decision, the CCPA held:

We disagree with the supposed logic of the Patent Office position. The Examiner and the board appear to hold that the mere existence of "functional and mechanical equivalence" establishes "obviousness". We think this involves a non-sequitur. Expedients which are functionally equivalent to each other are not necessarily obvious in view of one another. The statutory mandate of 35 U.S.C. 103 is that the claimed subject matter be unobvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. [Emphasis theirs]

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Likewise, as stated by the CCPA in *In re Flint*, 141 USPQ 299 (1964):

The defect which we find in the reasoning employed below [i.e. the invention did not attain a result or function not attained by the prior art] to support the rejection here is not only that it ignores the express provision of the statute as stated in section 103 but that it also ignores the fact that it is advantageous to the public in the promotion of progress of the useful arts, the Constitutional objective of the patent law, to provide inducement for the invention of devices which are the functional equivalents of devices already known. It is not the object of the policy behind the patent system to encourage satisfaction with or commercialization only of the first device for performing a given function that happens to come along. And for those who may be interested in promoting competition in the interest of the consuming public, the greater the number of functionally equivalent devices which are encouraged onto the market by patent protection, the better off the consumer will be. Therefore the test is obviousness of the invention and not whether it serves the same purpose as previous inventions. [emphasis theirs, material in brackets added]

Thus, even assuming that the structure of assignee's prior patent documents is equivalent, for the sake of argument, does not support that the recitations of the claims (which apparently the Examiner concedes do not exist) are obvious. Favorable reconsideration of the rejection of claims 15 and 17-20 is respectfully requested for this separate and independent reason.

It is agreed that Hunt and WO 01/05678 each discloses a closure portion for an access opening, but as recognized by Examiner Philip H. Leung does not disclose the use of wet seal type adhesive. However, it should be appreciated that portion 40a of seal 40 is specifically disclosed as being peelable and as failing during microwave cooking to provide venting (see column 9, lines 23-25 of Hunt and page 12, lines 12 and 13 of WO 01/05678). Thus, in addition to failing to disclose the use of wet seal type adhesive, Hunt and WO 01/5678 expressly teaches venting of the seal in contradiction to the recitations of claims 1 and 17.

Kim discloses the use of wet seal type adhesive for sealing tape of the tear band type. There is no suggestion in Kim that its disclosed package could be used in a microwave oven, that its package could expand, or that if its package did expand, whether or not the seal would vent as the result of expansion. It is respectfully submitted that a person skilled in the art would need the hindsight knowledge of the present invention in locating and combining in just the right way the elements of Kim relied upon by the Examiners in rejecting claims 1-5 and 21 of this application. As stated by the CCPA in *In re Van Wanderham, Worthley, and Comolli*, 154 U.S.P.Q. 20, 24,

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25 (1967):

Closely related to the doctrine of nonanalogous art is the doctrine forbidding hindsight reconstruction, also discussed in Potts, supra. In applying section 103, the Supreme Court recently cautioned against "slipping into hindsight." (case citations)

* * *

The opinion in Sporck further provides, 49 CCPA at 1043, 44, 45; 133 U.S.P.Q. at 363, 364:

Once appellant's solution to the problem of making a tapered wall frusto-cone is disclosed, it is easy to see how the prior references can be modified and manipulated to produce this type of cone. The change admittedly is simple and by hindsight seems obvious. However, the simplicity of new inventions is oftentimes the very thing that is not obvious before they are made.

* * *

It is of course true that the examiner was able to locate the Sato article. However, it appears that this was done through reading into the art the teachings of appellants' invention. In re Murray. We think the Patent Office's conclusion of obviousness is based on an impermissible hindsight reconstruction of the art. In re Sporck.

Our determination here is not without difficulty. However, we think the difficulty arises from not considering the subject matter as a whole and instead of focusing on the scientific principle involved...

Likewise, the CCPA stated in *In re Shapleigh*, 115 U.S.P.Q. 129, 133 (1957):

The test as to whether two references are from non-analogous arts is whether one seeking to solve a problem with respect to the embodiment of a reference in one art would be apt to seek the solution to said problem in the other art. (case citation)

Similarly, the CCPA in *In re Antle*, 170 U.S.P.Q. 285, 287-288 (1971) stated:

In Winslow we said that the principal secondary reference was "in the very same art" as appellant's invention and characterized all the references as "very pertinent art." The language relied on by the solicitor, quoted above, therefore, does not apply in cases where the very point in issue is whether one of ordinary skill in the

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art would have *selected*, without the advantage of hindsight and knowledge of the applicant's disclosure, the particular references which the examiner applied. As we also said in Winslow, "Section 103 requires us to presume full knowledge by the inventor of the prior art *in the field of his endeavor*"...but it does not require us to presume full knowledge by the inventor of prior art *outside* the field of his endeavor, i.e., of "non-analogous" art. In that respect, it only requires us to presume that the inventor would have that ability to select and utilize knowledge from other arts reasonably pertinent to his particular problem which would be expected of a man of ordinary skill in the art to which the subject matter pertains. (emphasis theirs)

In determining what is analogous art, the Court of Appeals for the Federal Circuit stated in *Union Carbide Corp. v. American Can Co.*, 724 F.2d 1567, 220 U.S.P.Q. 584 (1984):

In resolving the question of obviousness under 35 U.S.C., § 103, we presume full knowledge by the inventor of all the prior art in the field of his endeavor. However, with regard to prior art outside the field of his endeavor, we only presume knowledge from those arts reasonably pertinent to the particular problem with which the inventor was involved. The rationale behind this rule precluding rejections based on combination of teachings from references from nonanalogous arts is the realization that an inventor could not possibly be aware of every teaching in every art. Thus, we attempt to more closely approximate the reality of the circumstances surrounding the making of an invention by only presuming knowledge by the inventor of prior art in the field of his endeavor and in analogous arts.

The determination that a reference is from a nonanalogous art is therefore twofold. First, we decide if the reference is within the field of the inventor's endeavor. If it is not, we proceed to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved.

In the present application, why would a person skilled in the art be aware of tear band devices of Kim? In this regard, Kim provides no teachings that its "adhesive" would have application in other fields or uses than in tear band strips. It is respectfully submitted that the only reason one would select the "adhesive" of Kim (while discarding the other elements thereof) and then use that "adhesive" in a manner which is not suggested in Kim and to function in a manner which is not suggested by Hunt or WO 01/5678 would be for the sole purpose of recreating the present invention based solely upon hindsight knowledge. It is respectfully submitted that the rejections of claims 1-5 and 21 have been overcome. Favorable reconsideration is respectfully requested.

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It should be noted that claims 8 and 16 not only recite parallel bands but also that the parallel bands define a plurality of spaced, parallel spaces therebetween creating a tortuous path. It should initially be appreciated that the terms of the claims must be construed in context of the specification and drawings. It is respectfully submitted that a person skilled in the art would not consider the multiple layers of Nakano and/or Mizuno to be bands. Furthermore, it is respectfully requested that the Examiner identify where the plurality of spaced, parallel spaces are defined in Nakano and/or Mizuno to create a tortuous path. Thus, it is respectfully submitted that the rejection of claims 8, 9 and 16 has been overcome. Favorable reconsideration is respectfully requested.

Although Nakano discloses a V-shaped portion, such V-shape is not "between and parallel to the closure portion and the wall. It is respectfully submitted that the rejection of claims 9, 28 (as amended), 29 as filed and claim 31 as amended has been overcome for this separate and independent reason. Favorable reconsideration is respectfully requested.

Clearly, the structure of the seal recited in claims 8 and 16 and the V-shape of claim 9 are clearly not suggested by the prior art, and any obstacles existing as to their allowability is of a definitional nature. Thus, it is respectfully requested that Examiner Leung contact the undersigned for an interview so that any obstacles to allowance can be mutually resolved.

Burdette shows a packet cavity 10 in communication with the interior of the bag. It is respectfully requested that the Examiner identify where the vent opening is formed and how pressure is released from the interior of the package through the packet cavity 10 in a manner as recited in claim 22 as filed. Likewise, how does the Examiner contend that packet cavity 10 is formed by a seal between first and second walls as recited in claims 23 and 43 or any of the recitations of claims 24-28 and 45 as originally filed? It is respectfully submitted that the rejections based upon Burdette have been overcome for each of these separate and independent reasons. Favorable reconsideration is respectfully requested.

Komiya discloses a back seal part S having vent holes 4 which are formed by tearing a projection 3. It should be appreciated that back seal part S as shown in Figure 2 does not divide the interior of the bag into two portions as clearly shown in Figures 1 and 3, and that Figure 4 shows alternate embodiments. Thus, it is respectfully requested that the Examiner identify what is contended to be the chamber in Komiya and more importantly where a vent opening from the contended chamber is formed in the first wall as recited in claims 22 and 32 and even more so is

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a slit cut in the first wall as recited in claims 25 and 33. Furthermore, how does the V-shaped seal of Figure 4b of Komiya release pressure into a chamber having a vent opening as recited in claim 28? Furthermore, where does Komiya disclose a seal divided into first and second seal portions as recited in claims 23, 31 and 45 as originally filed? However, in a spirit of conciliation, claim 23 has been amended to further define the present invention in a manner to distinguish over the prior art. How does the prior art suggest the arrangements of elements recited in claims 36 and 37 as originally filed? Claim 29 has been amended to recite seal portion 40aa of the preferred embodiment which is not suggested in Komiya. Furthermore, how is the arrangement of claim 39 suggested by the prior art?

Therefore, since the claims of the present application have been shown to include limitations directed to the features of applicants' easily expandable, nontrapping, flexible paper, microwave package which are neither shown, described, taught, nor alluded to in any of the references cited by the Examiner and cited in the parent application, whether those references are taken singly or in any combination, the Examiner is requested to allow claims 1-29, 31-42, 44 and 45, as amended, of the present application and to pass this application to issue.

Respectfully submitted,

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Dated: February __, 2005.

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